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Donald R. Dunner
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.
901 New York Ave. N. W.
Washington, DC 20001-4413

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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte RICHARD S. BELLIVEAU

Appeal 2010-007121
Application 10/801,177
Technology Center 2800

Oral Hearing Held: August 12, 2010

Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*, LINDA E. HORNER, and MARC S. HOFF, *Administrative Patent Judges.*

APPEARANCES:

ON BEHALF OF THE APPELLANT:

DONALD R. DUNNER, ESQUIRE
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
901 New York Avenue, N.W.
Washington, D.C. 20001-4413

The above-entitled matter came on for hearing on Thursday, August 12, 2010, commencing at 9:02 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Victor Lindsay, a Notary Public.

THE USHER: Good morning. Calendar No. 38, Appeal No. 2010-007121, Mr. Dunner.

JUDGE MacDONALD: Good morning.

MR. DUNNER: Good morning, Your Honors.

JUDGE MacDONALD: Have you been here before? The reason we ask is --

MR. DUNNER: I have.

JUDGE MacDONALD: Okay, so you know you have about 20 minutes, and you can begin anytime you're ready. And if we ask questions and take up some of your time, you can have a little more at the end.

MR. DUNNER: I welcome the questions.

JUDGE MacDONALD: Start anytime you're ready.

MR. DUNNER: I'm ready. Your Honors, there are two fundamental problems with the rejections before you. One of them is that the Examiner, in our view, has totally mischaracterized what the elected invention was in the underlying application, and, secondly, he has totally ignored a critical case, the *Broward* case, which impacts heavily on the issues before us. So let me deal with the first point, and that is that he has mischaracterized what the elected invention is.

The Examiner has said that the elected invention is a flashlight with a flexible substrate containing light-emitting diodes. The fact is only Claim 5

is directed -- only original Claim 5 is directed to a flashlight and the -- while the original patent claims, other than Claim 5, are directed to flexible substrates, it's clear that that wasn't the basis for the restriction requirement. In fact, the Examiner was the one who identified the elected and nonelected claims, and 15 of the nonelected claims were directed to flexible substrates, so that couldn't have been the basis for his election. And a perfect illustration is Claim 10, the original Claim 10. If you read original Claim 10, it looks like almost identical to the other claims that were elected with the flexible substrate and light-emitting diodes on it, except that it also included ventilation holes. And while the problem is complicated by the fact that the Examiner took the unusual step of basing his restriction requirement on drawings rather than claims, leaving everybody, you and we alike, to figure out what the basis was for his requirement, it is clear, if you look at the claims, that every one of the claims on appeal have an element from the nonelected claim for -- except for Claim 78, which we'll talk about a little later. But --

JUDGE HORNER: Would original Claim 10 be a linking claim, in your view?

MR. DUNNER: Pardon, Your Honor?

JUDGE HORNER: Would original Claim 10 be a linking claim, in your view?

MR. DUNNER: Original Claim 10 could, arguably, be a linking claim. That's exactly right, Your Honor.

But the Examiner, for reasons, again, that are not entirely clear, but it's clear what the impact was, included Figure 3F. Now, Figure 3F had a

flexible substrate, but so did Figures 4, Figures 5, Figures 6, Figures 7 have flexible substrates.

JUDGE MacDONALD: Let me ask a question here, put you a little on the spot since I'm going to ask you to try to put yourself in the public's shoes and the Examiner's shoes. Given the original prosecution and the election restriction, exactly what notice would the public take away from that -- what's in the record for that original in terms of what the species are and what the distinctions are? What's concretely in the record that would carry forward and be applicable here in this reissue?

MR. DUNNER: Your Honor, I think the public would take away, though it takes work --

JUDGE MacDONALD: Well, without work.

MR. DUNNER: It takes work because --

JUDGE MacDONALD: No, no. I'm saying what would the public reasonably take away with just reading the record, an artisan looking at this? Because I'm struggling with the record. I'll put it --

MR. DUNNER: The public would take away the fact that flexible substrates -- flashlight was not the elected invention. Flexible substrate was not the elected invention because 15 of the nonelected claims had a flexible substrate. The best example -- if you look at Claim 10, you see it very clearly. It had a flexible substrate. It also had ventilation holes, and he included Figure 3F. Figure 3F is -- the focus of 3F was not to a flexible substrate. Though it says it has a flexible substrate, it also was usable with 3D and 3E, which might or might not have a flexible substrate, and the other figures also had flexible substrates. So what would the member of the

public take away? The member of the public would take away that there are two elements of the elected claims. One is a system with a flexible substrate containing light-emitting diodes, and 2 through 3F, a discrete circuit for individually controlling light source intensity. That's what the public would take away. The public could not possibly take away, in my opinion, what the Examiner in the reissue application, revisiting history, claims that he did, in my view. Every one of the claims on appeal, 13 through 82, involves a discrete circuit for individually controlling light source intensity and, therefore, we submit is covered by the elected group in 3F, and the Examiner has admitted that that's what 3F includes. And every one except Claim 78 also has an additional element of the nonelected figures. And so, we submit that the combination of 3F, which is an elected group, and elements from the nonelected figures make those claims linking claims, which leads to a second issue in the case, and that is the issue of what is a linking claim?

Now, everybody agrees that *Doyle* is the governing case, and *Doyle* makes it clear that you -- if you satisfy a two-part test, reissue is proper, and the two-part test relates to linking claims. There were linking claims in *Doyle*. They were classic generic claims. They were not the kind of linking claims that are involved in this case. And the test is, one, that the new claims are not of substantially similar scope compared to the nonelected claims, and, secondly, that the new claims or reissue claims could have been included in the original application. Except for Claim 78, the Examiner really doesn't take issue with whether or not the claims are of substantially similar scope because every one of them includes an element from the Group 4 nonelected claims in combination with the 3F embodiment. He

does take issue with whether they are linking claims. The Examiner cites *Doyle* because it involved a genus and cites the *MPEP* because it also refers to a genus.

JUDGE MacDONALD: Isn't though there a foundational problem for the position that *Doyle* is relevant here simply because you have to have a clear election restriction that people can understand in order to get to where -- to that point where you're going to look at that case law? I'm reading through the election restriction and I'm struggling to see what the distinction is between the elected and nonelected claims. So I'm not even certain that you can -- that an Examiner can raise that issue at this point.

MR. DUNNER: Your Honor, the Examiner created the problem. I have to admit, it's a strange -- I mean, I've been practicing for 50 years and I used to work in the patent office and I've never seen a restriction requirement like this. We struggled with it but we came up with what we think is a rational answer. The bottom line is, as *Doyle* points out, reissue practice

is --

JUDGE MacDONALD: But isn't it --

MR. DUNNER: -- a remedial practice to be construed liberally.

JUDGE MacDONALD: Yeah, but isn't it an equally rational answer to say we don't see a distinction back here and we see no reason for precluding these claims from the current reissue?

MR. DUNNER: No, it is not an equally rational explanation. Difficult as it is -- I'm not suggesting it's not difficult. I'm not standing here pretending that I read it in five minutes and said, ah ha, it is clear to the

world, but we spent a lot of time studying it and I think we've come up with the only rational distinction, because the Examiner -- any other distinction ignores the fact that 15 of the claims had flexible substrates, ignores the fact that he included 3F, ignores the fact that the -- that he admits that 3F is directed to discrete circuits individually controlled. So the Examiner's admissions and the fact -- what is in the nonelected claims -- the fact that the only rational explanation is -- Claim 10 is a perfect example. If you can come up with a rational explanation of why the Examiner included Claim 10 -- and he picked Claim 10 as a nonelected claim when 99 and 44/100 percent -- which tells you how old I am. That's a, you know, Ivory soap number -- of that claim is the flexible substrate, the only explanation is that it included a ventilation hole, which is one of the elements. If you -- as you have, if you read the spec, you'll see that the Group 4 included a whole lot of additional elements, and all of the claims on appeal have those additional elements with the exception of Claim 78. So I submit if somebody -- we should not suffer. I mean, we did our best.

JUDGE MacDONALD: Oh, I concur because I think that it has to be recognized. We're in the position the Examiner has to explain all of this to us and I'm not seeing that in the record, the original record or the -- the original application or the current record as to why the new claim should be precluded. I'm not seeing a clear justification from the original restriction that you shouldn't be permitted to add these claims. I think -- I see nothing in the rationale that the Examiner's giving. That's why I'm asking, do you see something in the original restriction that would preclude these claims from being added? Because I'm not seeing it.

MR. DUNNER: That would preclude the claims from being added. No, I don't see anything that would -- I misunderstood you.

JUDGE MacDONALD: I thought you might have.

MR. DUNNER: I don't see anything that would preclude the claims from being added for the reasons you have said. They all contain linking claims, and the *Broward* case --

JUDGE MacDONALD: Well, see, I don't agree that these are linking claims but I don't think that that's really relevant.

JUDGE HORNER: I think -- maybe putting this another way, the *Orita* doctrine looks at what the Appellant acquiesced to in the original prosecution --

MR. DUNNER: Right.

JUDGE HORNER: -- and prohibits going back and recapturing that because you would undermine the copendancy requirements of 120 and 121. If the record isn't clear as to what the restriction was in the beginning and what the Appellant actually acquiesced to, does the *Orita* doctrine even apply here? Can we say that there's clearly on the record an attempt to undermine that copendancy requirement?

MR. DUNNER: Yes, you can, Your Honor. And I think the answer is that *Orita* was -- or *Orita,*- however one pronounces it --

JUDGE MacDONALD: Well, can I --

MR. DUNNER: -- was discussed in *Doyle.*

JUDGE MacDONALD: Yeah, can I interrupt for one second? As I think a little more perhaps -- because if that doesn't apply, we don't see a basis then for precluding the claims. The claims should come in if -- if

this --

MR. DUNNER: Well, Your Honor, I agree. I agree with you. And *Doyle* set forth -- it discussed *Orita*, or *Orita*, and then said this is a different case. And *Broward*, I know you say it doesn't matter, but in case, after this is over and you're talking and it does matter, *Broward* has the same -- exactly the same kind of linking claims as are involved in this case.

So with that, Your Honors, if there are any questions, I would welcome them and be glad to try to answer them.

JUDGE MacDONALD: I'm good.

JUDGE HORNER: Not me. No further questions.

JUDGE HOFF: No, no questions.

MR. DUNNER: Well, thank you, Your Honors. I appreciate your --

Whereupon, the proceedings, at 9:16 a.m., were concluded.